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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,681	05/22/2002	Kalevi Ratschunas	4925-219PUS	2735

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Michael C Stuart  
Cohen Pontani Lieberman & Pavane  
551 Fifth Avenue Suite 1210  
New York, NY 10176

EXAMINER

HASHEM, LISA

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/089,681

Applicant(s)

RATSCHUNAS ET AL.

Examiner

Lisa Hashem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 13 is objected to because of the following informalities: the phrase ‘...a message generating device, wherein said message generating...’ is incomplete. Appropriate correction is required.
2. Intended Use Limitations: A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art – if the prior art has the capability to so perform (see MPEP 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (1987). Thus the claim limitations in the examined claims that employ phrases of type: “FOR” doing something, e.g. ‘a setting means for’, ‘a judging means for’, ‘a transmitting means for’, ‘a supplying means for’, etc. These are typical of claim limitations, which may not distinguish over the prior art. The references noted below have the structure and functions of performing the claimed limitations.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 1 recites the limitation "the result" and "the steps". There is insufficient antecedent basis for these limitations in the claim.
5. Claims 3 and 15 recite the limitation "the location". There is insufficient antecedent basis for this limitation in these claims.
6. Claims 6 and 20 recite the limitation "the originator". There is insufficient antecedent basis for this limitation in these claims.

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7. Claim 12 recites the limitation "the deciding result". There is insufficient antecedent basis for this limitation in the claim.

8. Claim 13 recites the limitation "said message generating". There is insufficient antecedent basis for this limitation in the claim.

9. Claim 21 recites the limitation "said group identifier". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-5, 10-11, 12-17, 22-23, 24-28, and 29-34 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent No. 6,119,014 by Alperovich et al, hereinafter Alperovich.

Regarding claim 1, Alperovich discloses a method for delivering messages in a network comprising at least one terminal device, comprising steps of generating a message, setting a message, condition for receiving said message, deciding whether said message is to be received by a terminal device (Figure 3, 300) on the basis of said condition, and transmitting said message to said terminal device on the basis of a result of the deciding step (column 4, line 7 – line 51).

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Regarding claim 2, the method according to claim 1, wherein Alperovich further discloses said setting step is performed by a terminal device (Figure 3, 380; column 4, lines 7-12).

Regarding claim 3, the method according to claim 1, wherein Alperovich further discloses said condition is a location of said terminal device (Figure 3, 300; column 5, lines 26-35).

Regarding claim 4, the method according to claim 1, wherein Alperovich further discloses the step of including information regarding said condition in an optional field of said message (column 5, lines 8-14 and lines 26-30).

Regarding claim 5, the method according to claim 1, wherein Alperovich further discloses the step of determining said terminal device (Figure 3, 300) as being inactive or busy in case it is decided that said condition is inherently not met (column 2, lines 20-28; column 2, line 64 – column 3, line 11).

Regarding claim 10, the method according to claim 1, wherein Alperovich further discloses said message is a multimedia message (column 2, lines 60-63).

Regarding claim 11, the method according to claim 1, wherein Alperovich further discloses said network is a mobile network (see Figure 3) and said terminal device is a mobile terminal device (Figure 3, 380; originating subscriber).

Regarding claim 12, Alperovich discloses a network system for delivering messages in a network, comprising a message delivering device or SMS service center (Figure 3, 360); and a terminal device (Figure 3, 300); wherein said message delivering device comprises a deciding means adapted to decide whether said message is to be received by said terminal device on the

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basis of a condition for receiving said message, and a transmitting means adapted to transmit said message on the basis of the deciding result of said deciding means to said terminal device (column 4, line 7 – column 5, line 7).

Regarding claim 13, the system according to claim 12, wherein Alperovich further discloses a message generating device, wherein said message is generated (column 2, lines 59-63).

Regarding claims 14-17 and 22-23, please see the rejections of claims 3-5 and 10-11 mentioned above, respectively, to reject the system in claims 14-17 and 22-23.

Regarding claims 24-28, please see the rejections of claims 12, 15, 16, 22, and 23 mentioned above, respectively, to reject the report delivery condition setting device in claims 24-28. Wherein the report delivery condition setting device is mobile unit of the originating subscriber (column 4, line 52 – column 5, line 25).

Regarding claims 29-34, please see the rejections of claims 12, 15, 16, 17, 22, and 23 mentioned above, respectively, to reject the message delivering device in claims 29-34.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 6-9 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,119,014 by Alperovich, as applied to claims 1 and 12 above, respectively, in view of U.S. Patent No. 6,289,223 by Mukherjee et al, hereinafter Mukherjee.

Regarding claim 6, the method according to claim 1, wherein Alperovich further discloses the step of deciding whether the originator of said message is permitted to receive a failure report, and transmitting said failure report to the originator of said message and deciding whether the Service Center of said message is permitted to receive a delivery report, and transmitting said delivery report to said Service Center (column 2, lines 20-28).

Alperovich does not disclose the step of deciding whether the originator of said message is permitted to receive a delivery report, and transmitting said delivery report to the originator of said message only in case said originator of said message is permitted.

Mukherjee discloses a system and method for enabling an originating mobile unit to deliver SMS messages to a select plurality of destination mobile units (see Abstract). Wherein the method comprises steps of generating a message, setting a message, condition for receiving said message (if the originator is allowed to access a receiving subscriber or receiving group of subscribers), deciding whether said message is to be received by terminal device(s) () on the basis of said condition, and transmitting said message to said terminal device on the basis of a result of the deciding step (column 3, line 3 – column 4, line 37). Wherein Mukherjee further discloses the step of deciding whether the originator of said message is permitted to receive a delivery report, and transmitting said delivery report to the originator of said message only in case said originator of said message is permitted (column 6, lines 21-30).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Alperovich to include the originator of said message is permitted to receive a delivery report as taught by Mukherjee. One of ordinary skill in the art would have been lead to make such a modification since the originator of said message can

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receive a delivery report based on successful transmission and there are no user restrictions in message delivery to a group of users based on interrogation of a multipoint user group database.

Regarding claim 7, the method according to claim 6, wherein Mukherjee further discloses the step of storing a list of originators of messages in a database which are permitted to receive delivery reports (column 6, lines 21-30).

Regarding claim 8, the method according to claim 6, wherein Mukherjee further discloses the step of defining a group of users which are allowed to receive delivery reports, wherein in said deciding step it is detected whether the originator of said received message is a member of said group of users (column 3, line 46 – column 4, line 37; column 6, lines 21-30).

Regarding claim 9, the method according to claim 8, wherein Mukherjee further discloses the step of adding a group identifier identifying said group of users to said message (column 3, line 46 – column 4, line 37).

Regarding claims 18-21, please see the rejections of claims 6-9 mentioned above, respectively, to reject the system in claims 18-21.

14. Claims 35-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,119,014 by Alperovich in view of U.S. Patent No. 6,289,223 by Mukherjee.

Regarding claims 35-39, please see the rejections of claims (1 and 6 for claim 35), 7, 3, 10, and 11 mentioned above, respectively, to reject the terminal device in claims 35-39.



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***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent No. 5,930,239 by Turcotte discloses a method and system for message signaling, wherein privacy and urgency indicators and sub-addressing are provided to segregate messages. Delivery receipt information is used to request a message center to provide a receipt to an originating mobile station upon delivery of a message to a destination user

16. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
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**Or faxed to:**

(703) 872-9314 (for formal communications intended for entry)

**Or call:**

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to: Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (703) 305-4302. The examiner can normally be reached on M-F 8:30-5:30.

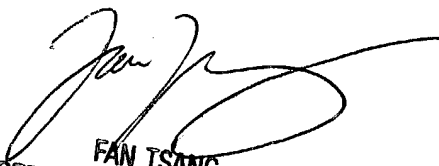
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

LH

lh

November 9, 2004

  
FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600